

REMARKS

Claims 4-40, 44-45 and 55-82 are pending. By this Amendment, claims 1-3, 41-43, 46-48 and 51-54 are canceled without prejudice or disclaimer, claim 24 is amended and claims 60-83 are added.

Support for the amendment to claim 24 is found in the specification at least in Figs. 2 and 8-9 and at paragraphs [0013], [0028] and [0032]. Support for new claims 60-65 and 80-82 is found at least at paragraph [0009]. Support for new claim 67 is also found at least in the same figures and passages. Support for new claims 66 and 78 and is found at least at paragraph [0034]. Support for new claims 68-69 is found at least at paragraph [0031]. New claims 70-77 and 79 correspond respectively to dependent claims 25, 59, 26-30, 58 and 45. Support for new claim 83 is found at least in Figs. 8-9.

Applicants thank Examiner Brown for the courtesies extended to Applicants' representative during a June 1, 2006 telephone interview. During the interview, Applicants' representative discussed the "metallic layer having a plan-view shape...[that is] continuous over the eyeball-covering area" feature that is now added to claim 24, and how it distinguishes from the Langley reference, which discloses a layer that is not continuous but instead has pores 16 formed therein. While not committing to whether this language makes the claim allowable, the Examiner agreed that this feature (1) is supported by the specification and drawings and (2) would be very helpful in moving the claim toward allowance.

Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

I. The Claims Define Patentable Subject Matter

A. The Office Action rejects claims 24-25, 34, 40 and 58-59 under 35 U.S.C. §103(a) over U.S. Patent No. 4,969,472 to Langley et al. ("Langley") in view of U.S. Patent

No. 2,527,947 to Loos; and rejects claims 26-33, 35-39, 45 and 50 under 35 U.S.C. §103(a) over Langley in view of Loos and further in view of U.S. Patent No. 4,867,146 to Krupnick et al. ("Krupnick") and U.S. Patent No. 5,469,864 to Rosenblatt. These rejections are respectfully traversed.

1. Independent Claim 24

Claim 24 recites, *inter alia*, a metallic layer having a plan-view shape, the plan-view shape including an eyeball-covering area that completely covers an eyeball, the plan-view shape being continuous over the eyeball-covering area. This feature clearly is absent from Langley.

The "eyeball-covering area" of the Langley eye patch (metallic layer) includes pores 16, and therefore is not continuous. The pores 16 are important to the Langley eye patch "to provide a steady inflow of air," as can be seen from, e.g., col. 3, lines 32-36. The importance of the pores 16 is particularly apparent from the fact that, even when it is desired to prevent light from entering the eye, Langley does not teach that the pores 16 should be eliminated, but rather teaches that cotton, gauze or other material should be placed behind the patch (col. 3, lines 34-36). Thus, it would not have been obvious to make the Langley metallic layer continuous at the eyeball-covering area, despite any teaching of Loos or any other reference. For at least this reason, claim 24 is patentably distinct from the applied prior art.

Should any previous rejection be maintained, or any new rejection involving Langley be applied in a new Office Action, Applicants respectfully request that such Office Action respond to the points raised in Applicants' previous response. Applicants require an adequate response in any such maintained or new rejection.

First, in asserting that there would have been no motivation to combine the references, Applicants pointed out that the Langley eye patch is already prevented from being dislodged because it is held in place by tape or a headband, and thus it would not have been obvious to

size it to fit inside the eye socket merely for the purpose of preventing it from being dislodged. In response to this point, the Office Action simply states, "Langley was used to set forth the environment of the patch. Loos was used as a modifier to make the eye patch so it fits inside of the eye socket. Whether the tape or the headband is used to hold the eye patch in place is moot."

That response does not fit within the legal framework of an obviousness analysis. Even though "Langley was used to set forth the environment of the patch," that environment is very relevant to the issue of motivation, and must be considered in its entirety. Langley's disclosed tape or headband holding the eye patch in place are part of the disclosed environment, and refute the Office Action's position that there would have been motivation to hold the patch in place in some other way. Therefore, "whether the tape or the headband is used to hold the eye patch in place" is not "moot," but rather bears heavily on the issue of motivation.

Second, Applicants asserted that it would not have been obvious to one of ordinary skill in the art to size the Langley eye patch to fit within the human eye socket, because doing so would be contrary to Langley's teachings. The Langley eye patch is intended to protect a wearer's eye "during a post-surgery period or after injury to the eye" (col. 1, lines 14-15). If the eye patch were sized to fit inside the eye socket, it would be difficult or impossible to apply the eye patch without putting some pressure, or risking putting some pressure, on the sensitive eye, which clearly would be undesirable for an eye that has been injured and/or surgically operated upon.

In its response, the current Office Action does not correctly address the issue of obviousness, instead addressing the issue as a matter of what the prior art is "capable" of doing. The Office Action completely fails to respond to the point that, if the Langley eye patch were modified as suggested (i.e., to be small enough to fit within the eye socket), it

would not be suitable for its disclosed intended use. The issue of whether the device may be capable of other, undisclosed uses is not relevant here. The fact is that the proposed modification would make the device unsuitable for its intended purpose, which is contrary to the law governing the obviousness analysis. See, e.g., MPEP §2143.01.V., entitled "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE." The Office Action's position on this point does not satisfy the law explained in this section of the MPEP.

Third, Applicants pointed out that the "metallic layer" of the Langley eye patch would not protect an eye from laser light. In response, the Office Action asserts that "any patch that covers the eye that isn't transparent is capable of protecting the eye from a laser," and that "if any light passes through the pores gauze or other material can be placed behind the pores to prevent light from passing."

The first of these statements is a generalization that is unsupported by any evidence, and which is, from a technical standpoint, simply incorrect, as well understood by those skilled in the art. The second statement shows that the Office Action has failed to analyze the prior art vis-à-vis claim 24, because claim 24 recites that the metallic layer is what protects the eye from laser light. The gauze or other material disclosed by Langley is not a metallic layer.

For any or all of the foregoing reasons, claim 24 is patentably distinct from the applied prior art.

2. Claims Dependent From Claim 24

Krupnick and Rosenblatt do not overcome the above-noted deficiencies of Langley and Loos with respect to claim 24. For at least this reason, all of the rejected claims and new claims depending from claim 24 are patentably distinct from the applied prior art.

Additionally, new dependent claims 63-65 recite methods respectively involving a light procedure, laser surgery and a laser procedure. The applied prior art clearly does not disclose such treatments.

3. The Office Has Not Established a *Prima Facie* Case of Obviousness Regarding Claimed Thickness Or Materials

The various dependent claims reciting specific materials, thicknesses or ranges of thickness of the sheet member or metallic layer have not been adequately addressed by the Office Action. The Office Action rejects these claims simply on the basis that the dimensions or materials recited in the claims are "not critical." In the previous response, Applicants pointed out that the Office cannot shift the burden of proof on this point without first establishing a *prima facie* case of obviousness. The current Office Action does not respond to this point, but simply states that "the specification lacks a showing of criticality." Applicant maintains that the rejection of these claims is improper because the Office has not met its burden of establishing a *prima facie* case of obviousness.

To reiterate, the MPEP explains that a showing of criticality, or unexpected results, "can rebut a *prima facie* case of obviousness based on overlapping ranges" (MPEP §2144.05, emphasis added). In other words, when the prior art discloses a range that overlaps the claimed range, then the applicant must show the criticality of the claimed range in order to rebut the *prima facie* case of obviousness established by that disclosure in the prior art.

In this case, however, the prior art does not even discuss thicknesses, and does not disclose various ones of the materials claimed. Thus, a *prima facie* case of obviousness, e.g., evidence of overlapping ranges, has not even been established. It is improper to require a showing of criticality in such a situation.

Should the Office maintain its position that it need not first establish a *prima facie* case of obviousness to shift the burden to Applicants to show criticality, Applicants respectfully request citation of a rule or case supporting such position.

* * *

Accordingly, claim 24 and all claims dependent therefrom are patentably distinct from the applied prior art. Applicants respectfully request reconsideration and withdrawal of the rejections.

B. New claim 68 recites, *inter alia*, a laser-resistant layer of foil or film attached to a sheet member for protecting an eye from laser light. The applied references do not teach or suggest a foil or film. The metallic layer of Langley is rigid (see, e.g., col. 1, lines 19-21), and it would be readily recognized by those skilled in the art that Langley's metallic layer is not a foil or film. For at least this reason, claim 67 and all claims dependent therefrom are patentably distinct from the applied prior art.

C. New claim 83 recites, *inter alia*, a sheet member and a metallic layer that protects an eye from laser light, the sheet member being on only one side of the metallic layer. In contrast, in the Langley eye patch, the garter 10 (sheet member) is on both sides of the metallic layer, and must be so in order to operate in the designed manner as described at, for example, col. 3, lines 54 - col. 4, line 34. For at least this reason, claim 82 is patentably distinct from the applied prior art.

II. The Election of Species Requirement Should Be Withdrawn

Applicants have repeatedly asserted that the Election of Species Requirement should be withdrawn, and have explained in detail why it is in error. In response to Applicants' point, quoted from the MPEP, that "claims are never species" and "species are always the specifically different embodiments," the Office Action asserts that "claims determine if there

are different species" and "the drawings show and the claims recite the different species as set forth in the restriction."

The first of these statements is completely incorrect and is in direct contradiction to the language of the MPEP. To reiterate, MPEP §806.04(e) states that "[c]laims are never species." (Emphasis in original.) The disclosure, not the claims, determines whether there are species.

The "drawings show the different species" portion of the second statement is correct, but has not been followed by this Office Action, or the previous Office Actions, all of which continue to refer to the species in terms of claims sets, not in terms of the drawings.

Regarding the "claims recite the different species" portion of the second statement, while claims can be limited to species, species can't be defined solely by the claims. For example, this is well illustrated by the situation in the present application. The Election Requirement defined "species" solely in terms of claims, and in response Applicants elected the "species" defined as "Group IV, claims 24-40, 45 and 50." Under that definition, no new or amended claims could ever be readable on the elected species defined as "claims 24 -40, 45 and 50," because the new or amended claims would not be identical to the claims of the defined "species." This result of potentially precluding any new or amended claims from examination simply because they are new or amended is clearly not consistent with the intent of Election of Species practice.

Accordingly, Applicants continue to maintain that the Election of Species Requirement is improper and should be withdrawn.

As explained in the Response to Election of Species Requirement filed November 1, 2004, it would be more appropriate to classify the species in this application as "Species I, Figs. 1-7; Species II, Fig. 8; and Species III, Fig. 9." If the Patent Office agrees to this

classification, then Applicants elect Species III, Fig. 9. All of the pending claims are readable on the elected species, and claims 24-40, 45 and 50 are generic to Species II and III.

Withdrawn claim 4 and its dependent claims are patentably distinct from the applied prior art at least because of the "first and second sheet members...permanently adhered together" feature.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Amendment Transmittal
Request for Continued Examination
Information Disclosure Statement

Date: June 8, 2006

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